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PATENT  
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
Calmer, Marion	)	
	)	Examiner: Torres, Alicia M.
Serial No.: 10/623,322	)	
	)	
Filed: 07/19/2003	)	Art Unit: 3671
	)	
For: Penetrating Stalk Rolls	)	
	)	Docket No.: USPA-0018

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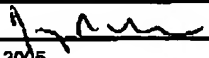
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<b>TRANSMITTAL FORM</b> (to be used for all correspondence after initial filing)	Application Number	10/623,322	
	Filing Date	07/19/2003	
	First Named Inventor	Marlon Calmer	
	Art Unit	3671	
	Examiner Name	Torres, Alda M.	
Total Number of Pages in This Submission	14	Attorney Docket Number	USPA-0018

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<input type="checkbox"/> Response to Missing Parts/Incomplete Application	<b>Remarks</b> Response to Notice requiring excess claims fees in response to RCE filed by Applicant on September 8, 2005. Applicant has cancelled claims to reduce excess fees due from \$900.00 to \$375.00.	
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53		
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PATENT  
IN THE UNITED STATES PATENT AND TRADEMARK OFFICEIn re Application of:  
Calmer, Marion

Serial No.: 10/623,322

Filed: 02/28/2003

For: Penetrating Stalk Rolls

Examiner: Torres, Alicia M.

Art Unit: 3671

Dear Ms. Torres:

10/17/2005 TL0111 00000034 10623322

01 FC:2202

375.00 OP

Applicant submits this amendment in response to the Office Action dated December 22, 2004. Applicant previously submitted a request for continued examination on September 8, 2005. Subsequent, Applicant received a notice requiring excess claim fees. Applicant has revised the amendment and request for continued examination filed on September 8, 2005. Applicant requests the Examiner review the original claims 1-10 and Claim 20 again in light of Applicant's arguments. Applicant has cancelled claims 11-19. Per the Examiner's direction in the office action, Applicant has also included new claims 21-40 further incorporating the patent specification disclosure.

**CLAIMS**

Applicant encloses a claim listing as required by 37 C.F.R. 1.121 including previously presented claims 1-20. Typographical and spelling errors in Claims 1-20 as previously presented have been corrected. Claims 21-40 are newly presented.

**CLAIM REJECTIONS**

The Examiner has rejected claims 1-3, 6 and 7, 9 under 35 U.S.C. 103(a) as being unpatentable over Russell (U.S. Pat. #3,304,702) in view of Lundahl (U.S. Patent #5,309,702); claims 4 and 5 are also rejected under 35 U.S.C. 103(a) over Russell and

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Lundahl in view of Calmer (U.S. Patent #5,704,202); claims 8 and 10 are also rejected under 35 U.S.C. 103(a) as being unpatentable over Russell and Lundahl, further in view of Sutton.

The Examiner has the burden of making a prima facie case of obviousness. The Examiner has not carried this burden in this case. The Examiner cannot review the prior art and use a combination of elements from non-analogous sources, in a manner that reconstructs the Applicant's invention only with the benefit of hindsight. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself.<sup>1</sup> Furthermore, in attempting to make the prima facie case for obvious under 35 U.S.C. 103 (a), the Examiner has chosen among individual parts of assorted prior art references to reconstruct applicant's invention which is impermissible.<sup>2</sup> The Examiner in her reliance on the teachings of several prior art references, has not looked at the invention as a whole but only the various pieces or features of the invention.<sup>3</sup>

<sup>1</sup> See In re Oetiker, 977 F.2d 1443, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992)

<sup>2</sup> See Akzo N.V. v. United States Int'l Trade Comm'n, 1 USPQ 2d 1241, 1246 (Fed. Cir. 1986), *cert. denied*, 482 U.S. 909 (1987) (stating that prior art references before the tribunal must be read as a whole and consideration must be given where the references diverge and teach away from the claimed invention. . . . [m]oreover, appellants cannot pick and choose among individual parts of assorted prior art references "as a mosaic to recreate a facsimile of the claimed invention."

<sup>3</sup> See Ex parte Hiyamizu, 10 USPQ 2d 1393, 1394-95 (B.P.A.I. 1988) (hold that under 35 U.S.C. 103 where the examiner has relied on the teachings of several references, the test is whether or not the references viewed individually and collectively would have suggested the claimed invention to the person possessing ordinary skill in the art. It is to be noted, however, that citing references which merely indicate that isolated elements and/or features recited in the claims are known is not a sufficient basis for concluding that the combination of claimed elements would have been obvious. . . . Furthermore, it is well settled that where the claimed invention solves a problem, the discovery of the source of the problem and its solution are considered to be part of the "invention as a whole")